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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,915	11/05/2003	Anthony R. Rogers	RJSTUDIO-2	7787
32132	7590	07/13/2004	EXAMINER	
LAMORTE & ASSOCIATES P.C.			FRANCIS, FAYE	
P.O. BOX 434				
YARDLEY, PA 19067			ART UNIT	PAPER NUMBER
			3712	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/700,915	ROGERS, ANTHONY R.	
	Examiner	Art Unit	
	Faye Francis	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/5/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10, drawn to a novelty bank assembly, classified in class 446, subclass 8.
 - II. Claims 11-18, drawn to a method of operating for a novelty bank, classified in class 109, subclass unknown.
 - III. Claims 19-20, drawn to a bank assembly, classified in class 232, subclass unknown.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process. For example the product recited in claims 1-10 can be made without the step of causing the animated character to move through a selected animation pattern each time the money is added or removed from the money compartment as recited in the method claim 11.
3. Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2)

that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process. For example the product recited in claims 19-20 can be made without the step of causing the animated character to move through a selected animation pattern each time the money is added or removed from the money compartment as recited in the method claim 11.

4. Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require the audio phrase generator. The subcombination has separate utility such as the bank assembly can be used for ATM.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Mr. Eric Lamorte on Tuesday July 6, 2004 a provisional election was made with traverse to prosecute the invention of group I, claims 1-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1: the phrase "at least one money port disposed in said bank structure for passing money into said at least one money port" is confusing. Additionally, the phrase "the character is animated when money is passed into said at least one money port and when said access door is opened" is confusing given the applicant own discloser since it is not clear whether the character is animated when both the money is passed into the at least one money port and when the access door is opened or either when the money is passed into the at least one money port or when the access door is opened.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim.

Kim discloses all of the elements of these claims including a novelty bank assembly [saving box 1] comprising: a bank structure that defines an internal money compartment [coin storing portion], an access door [shutter 20] disposed in the bank structure for selectively accessing the money compartment, at least one money port [success section 13 or failed section 14] and a character [doll 72] coupled to the bank structure wherein the character is animated when money is passed into the at least one money port and when the access door is opened [subsection 0055]. Additionally, Kim discloses a speaker [sound generator 60] for broadcasting a selected audio message when the character is animated [subsection 0055] and a memory containing a plurality of audio messages ["congratulation" and "sorry! Try again"].

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim in view of Krvavica et al, hereinafter Krvavica.

Kim discloses most of the elements of this claim but for a microphone.

Krvavica teaches that it is conventional to have a microphone in an animated figure allowing the user to record and play back audio messages. It would have been obvious to one of ordinary skill in the art at the time the invention was made, in view of

Krvavica to provide the device of Kim with microphone to make the device more enjoyable for the children to play with by personalizing it.

13. Claims 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim in view of Woods.

Kim discloses most of the elements of this claim but for the plurality of audio messages contains a plurality of message types, wherein an audio message from a different message type is selected and broadcast depending upon whether money is added or removed from the bank structure and a money presence sensor for sensing if at least a predetermined minimum amount of money is present within the money compartment.

Woods teaches the concept of providing a novelty bank with a coin sensor 32 within the money compartment and sensing if at least a predetermined minimum amount of money [old weight] is present within the money compartment [col 4 lines 1-22] and a plurality of audio messages that contains a plurality of message types wherein an audio message from a different message type is selected and broadcast depending upon whether money is added [Oink sound] or removed [squeal sound] from the bank structure [col 3 lines 43-57 and col 4 lines 23-36]. It would have been obvious to provided the device of Kim with the missing elements as taught by Woods in order to ensure that the child does not get board with the bank.

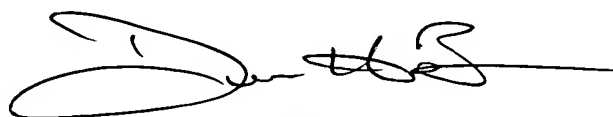
Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 703-306-5941. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FF



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